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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/062,552      | 04/20/1998  | YOSHINOBU SHIRAIWA   | 35.G2135            | 3178             |

5514 7590 09/10/2002

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NEW YORK, NY 10112

EXAMINER

WALLERSON, MARK E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2622

DATE MAILED: 09/10/2002

25

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/062,552

Applicant(s)  
Shiraiwa

Examiner  
Mark Wallerson

Art Unit  
2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 13, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 80-93 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 80, 81, and 83-93 is/are rejected.
- 7) ☒ Claim(s) 82 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other:  |

Art Unit: 2622

### **Part III DETAILED ACTION**

#### ***Notice to Applicant(s)***

1. This action is responsive to the following communications: amendment filed on 6/13/2002.

2. This application has been reconsidered. Claims 80-93 are pending.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 88- 93 are rejected under 35 U.S.C. 102(e) as being anticipated by Murata (U. S. 6,111,659).

With respect to claims 88, 90, 92 and 93, Murata discloses a recording control apparatus for controlling recording of images in a recording medium (memory card), the apparatus including a storage section (89) for storing a plurality of reproducible images and a reproduction instruction file (column 6, lines 40-46) containing instruction information including plural file names (figure

Art Unit: 2622

6) specifying image data to be reproduced (print control data) (column 6, lines 40-46), comprising an indication section for indicating deletion of at least one of the images (column 3, lines 36-44), and a control section for controlling deletion of the instruction information in the instruction file corresponding to the indicated image (column 3, lines 36-44).

With regard to claim 89, Murata discloses the recording medium is a detachable memory (column 3, lines 45-50).

With respect to claim 91, Murata discloses a display unit to display the image to be deleted (figure 16).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 80, 81, 83, 84, 85, 86, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata (U. S. 6,111,659).

With respect to claims 80, 81, 86, and 87, Murata discloses a storage unit using a recording medium (memory card), the recording medium having a plurality of reproducible images (image data files) and a reproduction instruction file (print job command file) containing plural file names specifying images to be reproduced (figure 6), the instruction file separate from

Art Unit: 2622

the plural images (column 6, lines 40-46); means for reading the reproduction instruction file (column 8, lines 52-60); means for controlling reproduction of the images by reading the images specified by the reproduction instruction file (column 8, line 52 to column 9, line 1), and printing a reproducible image specified by the instruction file if the reproducible image is recorded in the recording medium (column 8, line 52 to column 9, line 1).

Murata differs from claims 80, 86, and 87 in that he does not clearly disclose that reproduction is not performed for a particular image if that image is not recorded on the recording medium. However, it would be clearly obvious to one of ordinary skill in the art that if an image is not recorded on a recording medium (a disk), it cannot be read and printed.

With regard to claims 83, 84, and 85, Murata discloses means for displaying the file name of the image to be reproduced and the image to be reproduced (column 7, line 60 to column 8, line 51).

***Allowable Subject Matter***

7. Claim 82 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2622

*Response to Arguments*

8. Applicant's arguments filed 6/13/2002 have been fully considered but they are not persuasive.

Applicant submits that Murata does not disclose deleting the instruction information in the reproduction instruction file corresponding to the at least one image indicated by the indication section to be deleted if the instruction information corresponding to the at least one image is stored in the reproduction instruction file. The Examiner respectfully disagrees. Murata clearly discloses that when all the printing specified in the print job command file is completed, the CPU erases the print job command file and the image data file stored in the memory card (column 9, lines 2-4).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

Art Unit: 2622

(for informal or draft communications, such as proposed amendments to be discussed at an  
interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two

2121 Crystal Drive

Arlington. VA.

Sixth Floor (Receptionist)



MARK WALLERSON  
PRIMARY EXAMINER

MARK WALLERSON